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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,720	09/29/2003	Michelle D. Fabian	SP03-118	6332
22928	7590	05/04/2005	EXAMINER	
CORNING INCORPORATED			KIM, JOANNE H	
SP-TI-3-1			ART UNIT	
CORNING, NY 14831			PAPER NUMBER	
			2883	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/675,720	Applicant(s) FABIAN ET AL.	
	Examiner Joanne H. Kim	Art Unit 2883	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/21/05, 3/17/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gantt et al. (U.S. Patent No. 6,579,914, hereinafter "Gantt").

Regarding claims 1-12 and 15-23, Gantt discloses a coated optical fiber comprising: an optical fiber having a core and a cladding; a primary coating encapsulating the optical fiber, the primary coating having a Young's modulus less than about 2 MPa; and a secondary coating encapsulating the primary coating (column 2, lines 63-67; and column 3, lines 13-15). The primary coating is the cured reaction product of a primary curable composition comprising a polyether or polyester urethane (meth)acrylate oligomer, a monomer having a pendant hydroxyl group, and a monomer or oligomer having a poly(ethylene glycol) backbone and the primary curable composition is substantially devoid of organosilane adhesion promoters (0.1%) (for example, column 2, lines 20-24; column 5, lines 63-67; column 6, lines 1-2 and 59-62; column 8, lines 56-67; column 14, lines 18-19 and 40-45; and column 18, Example 3). Further, Gantt discloses that the optical fiber coating composition can be tailored by adjusting the molecular weight and polydispersity of the components of the composition

and/or by controlling the cure conditions to meet a particular set of optical fiber coating specifications (column 2, lines 33-43).

Gantt does not explicitly state that the primary coating is a hydrophilic coating. Further, Gantt does not specifically disclose that (1) the primary coating exhibits substantially no water bubble formation and substantially no delamination when the coated optical fiber is soaked in water at 23°C for 30 days and when the coated optical fiber is soaked in water at 65°C for 60 days, (2) the primary coating exhibits an average of less than about 20 water bubbles 1 μm or greater in diameter per mm of coated optical fiber when the coated optical fiber is soaked in water at 65°C for 60 days, (3) the primary coating has an average water absorption of at least about 4%, (4) the coated optical fiber has a dry pullout value of at least about 1 pound force, a 50% failure stress after being soaked in water at 65°C for 14 days that is within 10% of the 50% failure stress before being soaked, and a 50% failure stress after being exposed to 85% relative humidity at 85°C for 30 days that is within 10% of the 50% failure stress before the exposure, and (5) the secondary coating has a ductility of at least about 280 μm .

MPEP 2112.01 states that "where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977)" and that "products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the

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properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658. (Fed. Cir. 1990).” Further, MPEP 2114 states that “while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)” and that “a claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).”

Accordingly, it would have been obvious to one of ordinary skill in the art that the primary coating of Gantt is a hydrophilic coating since the claimed coated optical fiber and the coated optical fiber of Gantt are substantially identical in structure and composition and the products of identical chemical composition can not have mutually exclusive properties. Further, it would have been obvious to one of ordinary skill in the art that the coated optical fiber and the primary coating of Gantt have all the properties recited in claims 1-7, 11, 12, 15, 16, and 20-23 since the products of identical chemical composition can not have mutually exclusive properties. Additionally, it is inherent that the primary coating of Gantt is a hydrophilic coating since the composition of the primary coating includes hydrophilic components (i.e., a polyether or polyester urethane (meth)acrylate oligomer, a monomer having a pendant hydroxyl group, and a monomer or oligomer having a poly(ethylene glycol) backbone) as stated above. And, it would

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have been obvious to one of ordinary skill in the art that the primary coating of Gantt has an average water absorption of at least about 4% since the primary coating is a hydrophilic coating.

Regarding claims 13 and 14, it would have been obvious to form an optical fiber ribbon and an optical fiber cable comprising the coated optical fiber according to claim 1 in order to provide improved optical fiber ribbon and optical cable.

Response to Arguments

3. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

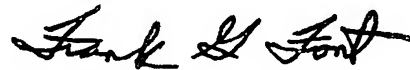
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne H. Kim whose telephone number is (571) 272-2139. The examiner can normally be reached on 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on (571) 272-2415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joanne H. Kim
Examiner
Art Unit 2883

jhk/FGF



Frank G. Font
Supervisory Patent Examiner
Technology Center 2800